

SEP 24 2007

60,469-037  
OT-4812REMARKS

Applicant thanks the Examiner for the remarks and analysis contained in the most recent Office Action. New claims 24-26 are presented. Applicant respectfully requests reconsideration of this application where claims 6-8 and 16-26 are currently pending.

Applicant respectfully traverses the rejection of claims 6-8, 17, 21 and 23 under 35 U.S.C. §103 based upon the proposed combination of *Wilcox* and *Harper*. The proposed combination cannot be made because it is contrary to MPEP 2143.01(V) and (VI), it provides no benefit and the *Wilcox* reference teaches away from the proposed combination. Each of those three reasons is independently dispositive and requires a conclusion that there is no *prima facie* case of obviousness. The fact that all three of them exist here is an overwhelming indication that there is no *prima facie* case of obviousness.

The Examiner can only establish a *prima facie* case of obviousness by indicating a reason why the teachings of the cited references would be combined. If a proposed combination would render the prior art unsatisfactory for its intended purpose or change the principle of operation of the reference, then that required reason does not exist (e.g., there is no motivation for making the suggested combination) and there is no *prima facie* case of obviousness. Similarly, where there is no benefit to a proposed combination, the reason for making it does not exist and there is no *prima facie* case of obviousness. Lastly, where a cited reference teaches away from a proposed combination, that combination cannot be made and does not establish a *prima facie* case of obviousness.

In this case, the *Wilcox* reference expressly requires utilizing a jacket material that includes wax. The *Wilcox* reference teaches that having a wax (e.g., a fatty acid amide) "present in the finished rope" is "beneficial." (See, e.g., column 3, lines 1-3 and lines 59-column 4, line 4) Therefore, the *Wilcox* reference teaches that to serve its intended purpose and maintain its desired principle of operation, a wax must be included in the finished product of that reference. The Examiner's proposal to remove wax from the jacket of the *Wilcox* reference would render

60,469-037  
OT-4812

the *Wilcox* reference unsatisfactory for its intended purpose. Therefore, MPEP 2143.01 requires a conclusion that there is no *prima facie* case of obviousness.

There also is no *prima facie* case of obviousness because the proposed combination provides no benefit in the context of the *Wilcox* arrangement. *Harper* wants a wax free outer surface on a foamed, molded article to facilitate painting that article (column 1, line 36 through column 2, line 20). The jacket of *Wilcox* is not painted. Therefore, the proposed addition of *Harper's* technique provides no benefit and there is no *prima facie* case of obviousness.

In fact, the proposed combination would remove a benefit required by the *Wilcox* reference. As already mentioned, the *Wilcox* reference includes a wax in the finished product as a beneficial feature. If one were to remove that wax from the finished product, not only would that not provide any benefit to the *Wilcox* arrangement, but moreover, it would remove a stated benefit that *Wilcox* desires. Such a modification to a reference cannot be made when attempting to establish a *prima facie* case of obviousness.

Further, there is no *prima facie* case of obviousness here because the *Wilcox* reference teaches away from the Examiner's proposed combination. The *Wilcox* reference teaches, for example, "It is an object of the present invention to provide a synthetic plastic rope which can be made using conventional rope making techniques and equipment." (Column 1, lines 44-46)

The Examiner's proposed combination requires taking *Harper's* technique that is different than "conventional rope making techniques" as desired by *Wilcox*. Therefore, the Examiner's proposed combination does not find any suggestion in the references. Instead, the *Wilcox* reference teaches away from the Examiner's proposed combination, which would require using some technique that is not conventional to the rope making art. The technique of the *Harper* reference has usefulness in the context of making molds that will be painted, which is not part of conventional rope making as mentioned by *Wilcox*.

The *Wilcox* reference expressly teaches that including a wax (e.g., fatty acid amide) in the finished product of *Wilcox* provides a benefit. (Column 3, lines 59-61) It, therefore, teaches away from an arrangement that would remove that beneficial wax. The *Wilcox* reference teaches away from the Examiner's proposed combination, which would remove *Wilcox's* beneficial wax.

60,469-037  
OT-4812

For any one of the three reasons mentioned above (e.g., the proposed combination renders *Wilcox* unsatisfactory for its intended purpose, the proposed combination provides no benefit and the *Wilcox* reference teaches away from the proposed combination), the rejection has to be withdrawn because there is no *prima facie* case of obviousness. Since all three of them are true, there is no *prima facie* case of obviousness and the rejection based upon the proposed combination of *Wilcox* and *Harper* must be withdrawn.

Applicant respectfully traverses the rejection of claims 16, 18-19, 20 and 22 based upon the proposed combination of *Wilcox*, *Harper* and *Aulanko, et al.* For the reasons already mentioned, *Wilcox* and *Harper* cannot be combined. The proposed addition of *Aulanko, et al.* does not remedy the defect in the improper base combination. There is no *prima facie* case of obviousness.

Applicant believes that this case is in condition for allowance and respectfully requests a Notice of Allowance as soon as possible. This case has now been pending for more than six years.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.

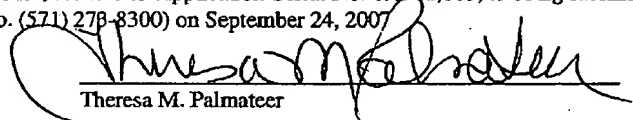


David J. Gaskey, Reg. No. 37,139  
400 West Maple, Suite 350  
Birmingham, MI 48009  
(248) 988-8360

Dated: September 24, 2007

CERTIFICATE OF FACSIMILE

I hereby certify that this Response, relative to Application Serial No. 09/921,803, is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 278-8300) on September 24, 2007.

  
Theresa M. Palmateer

N:\Clients\OTIS ELEVATOR\Up00037\PATENT\Response 8-07.doc